

REMARKS

Claims 1-36 are currently pending. Claims 1, 3, 5, and 7 were previously amended to better clarify what Applicants believe to be the invention. The support for the amendments were noted in the previous amendment and response to the Restriction Requirement. Accordingly, claims 1-36 are currently under consideration.

The Examiner has noted that the reply filed on May 6, 2004 by Applicants was not fully responsive to the previous requirement for restriction.

Applicants had previously elected Group II (claims 5-8, drawn to peptides of 21-40 amino acids and comprising a ZA loop) with traverse and had also elected Group A (SEQ ID NO: 3) as related to these claims, without traverse.

In addition, the Examiner has asserted that in order to be fully responsive, Applicants are to further elect a sequence to be searched that falls within the genus of sequences described by SEQ ID NO: 3.

With respect to the further restriction and to the election of a sequence that falls within the genus of sequences described by SEQ ID NO: 3, Applicants had elected to prosecute the synthetic bromodomain peptide of SEQ ID NO: 3 having modified residues at position (14), wherein the Xaa may be Pro, Lys or His, with traverse.

In response to the current Restriction Requirement, Applicants are required to elect a sequence to be searched that falls within the genus of sequences described by SEQ ID NO: 3.

Applicants' representatives would like to express their sincere appreciation for the telephonic discussion held with Examiner Zachariah Lucas on June 15, 2004 as related to the restriction requirement. As noted in that conversation, Examiner Lucas confirmed that the communication was a Restriction Requirement and not a species election.

In response to this Restriction Requirement, Applicants hereby elect SEQ ID NO: 19, with traverse.

Applicants respectfully request reconsideration of this further Requirement for Restriction, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that all of the sequences that fall within the genus described by SEQ ID NO: 3, with modified residues at position 14, wherein the Xaa may be Pro, Lys or His, are encompassed by four sequences, in particular, SEQ ID nOS: 19, 21, 27 and 28. These four sequences relate to a peptide comprising a ZA loop of a bromodomain, said bromodomain having between about 21 to 40 amino acids, and comprise the amino acid sequence of SEQ ID NO: 3, having the modified residues at position 14, as elected previously. While Applicants have elected SEQ ID NO: 19 as falling into the genus of SEQ ID NO: 3, Applicants assert that a search on the claims elected by way of the response to the restriction requirement which requires a search on the peptides of Group II, and more particularly the peptide of SEQ ID NO: 3, and the variants of the genus that fall within SEQ ID NO: 3, in particular, SEQ ID NO: 19, would not pose an undue burden on the Examiner.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that a search and examination on the merits of all of the sub sequences having the modified residues as outlined in SEQ ID NO: 3 can be made without serious burden. Thus, conjoint examination and inclusion of these sequences, in

particular, SEQ ID NOS: 19, 21, 27 and 28 together would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction is in order as related to the sequences that fall within the genus of SEQ ID NO: 3.

Fees

No fees are believe to be necessitated by the foregoing response. However, if this is in error, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

Conclusions

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the claims is courteously solicited.

Respectfully submitted,



Veronica Mallon, Ph.D.

Agent for Applicant(s)

Registration No. 52,491

KLAUBER & JACKSON
411 Hackensack Avenue
Hackensack, NJ 07601
(201) 487-5800